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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

HANNAHER, CONSTANTINE

ART UNIT

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2884

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/718,643	Applicant(s) YASUDA, HIROAKI	
	Examiner Constantine Hannaher	Art Unit 2884	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20090507</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on December 1, 2008 has been entered.

Information Disclosure Statement

2. As set forth in MPEP § 609.04(a):

37 CFR 1.98(b) requires that each item of information in an IDS be identified properly. U.S. patents must be identified by the inventor, patent number, and issue date. U.S. patent application publications must be identified by the applicant, patent application publication number, and publication date. U.S. applications must be identified by the inventor, the eight digit application number (the two digit series code and the six digit serial number), and the filing date. If a U.S. application being listed in an IDS has been issued as a patent or has been published, the applicant should list the patent or application publication in the IDS instead of the application. Each foreign patent or published foreign patent application must be identified by the country or patent office which issued the patent or published the application, an appropriate document number, and the publication date indicated on the patent or published application. Each publication must be identified by publisher, author (if any), title, relevant pages of the publication, date and place of publication. The date of publication supplied must include at least the month and year of publication, except that the year of publication (without the month) will be accepted if the applicant points out in the information disclosure statement that the year of publication is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the particular month of publication is not in issue. The place of publication refers to the name of the journal, magazine, or other publication in which the information being submitted was published. Pending U.S. applications that are being cited can be listed under the non-patent literature section or in a new section appropriately labeled.

Note the failure to identify U.S. patent application publications by the patent application publication number. The errors in the information disclosure statement cannot be considered a

matter of inadvertence in view of the presence of the INID codes on the document(s), see MPEP § 901.05(b).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 9-21 and 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not describe “an integrated photodetector” such that it might be understood that filters **33**, **40** and the detector **32** have any particular structure beyond the label afforded by reference symbol **30**. See page 12, lines 14-16 and FIG. **4C**. The specification does not describe the thicknesses of the two absorption filters as the same order of magnitude. See page 16, line 21 to page 17, line 1. The schematic illustration in FIG. **4C** is not so detailed that it alone may provide a written description. The claims are not entitled to a filing date earlier than December 1, 2008. The Examiner notes that this makes Lind *et al.* available under 35 U.S.C. 102(b) and further notes the prohibition of 35 U.S.C. 135(b). Indeed, it would make the publication of the continuation application available under 35 U.S.C. 102(b).

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 9-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The descriptions of integration in the specification are a combination of the stimulating light projecting system **20** with the photodetector **30** (see page 14, lines 13-16, which in view of the schematic illustrations of FIGs. **1** and **2** conveys nothing more than the elements should, perhaps, maintain the orientations and distances involved) and the combination of filters with each other or other optical elements. Since there can be no legitimate argument that the excitation and image acquisition station **18** in the disclosure of Mitchell *et al.* (FIG. **5**) fails to integrate the light source **24** and photodetector **58** as required by the specification, the meaning of any structural significance to “an integrated photodetector” which would distinguish the embodiment of FIG. **6A** of Mitchell *et al.* illustrating close proximity of filter **44** and detectors **38** is not apparent.

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Mitchell *et al.* is available to the examiner under 35 U.S.C. 102(e) even subsequent to the perfection of the claim to foreign priority by the submission of the translation of the priority document on December 7, 2006.

8. Claims 9-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell *et al.* (US 20030042445A1) in view of one of Struye *et al.* (US006583434B2) and Van de Bergh (US005905014A).

With respect to independent claim 9, Mitchell *et al.* discloses a device (FIG. **6A**) for acquiring latent image information in a phosphor layer (paragraph [0047]) comprising a light source **42**

(paragraph [0061]), a detector **38** (paragraph [0083]), and a filter device **44** (paragraph [0084]). The light source, detector, and filter device of Mitchell *et al.* are all for the recited purposes, see paragraph [0062], last two sentences, regarding the transparency and lack of transparency of filter device **44** in the device of FIG. **6A**. The filter device **44** of Mitchell *et al.* is fairly characterized as an absorption filter (paragraph [0062]) and is fairly described as “integrated” with the detector **38** in view of the common fixture (FIG. **2**) and the adjacency illustrated (FIG. **6A**). Thus, the remaining difference between the scope and content of Mitchell *et al.* and the claim is that Mitchell *et al.* does not identify the construction of “a filter **44**” (paragraph [0084]) as comprising at least two elements. The interchangeability of multiple filters for a single filter is recognized in the art (see column 9, lines 38-65 of Struye *et al.* and column 16, lines 19-35 of Van de Bergh). Because an express suggestion to substitute one known equivalent for another is not required (MPEP § 2144.06) it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the filter device **44** of Mitchell *et al.* such that it comprised at least two absorption filter elements joined to one another.

With respect to dependent claims 10-15 and 18, in view of the “glass filters with multilayer coatings” and “colored glass filters which may also be coated” of Mitchell *et al.* and the extensive knowledge of “filter types and spectral transmittance” available as described by Struye *et al.* and Van de Bergh, the specific transparency and non-transparency of individual filter elements in the filter device **44** of Mitchell *et al.* is a choice within the ordinary skill in the art. Multilayer coatings constitute a reflection layer.

With respect to dependent claims 16 and 19, the transmission of the filter device **44** of Mitchell *et al.* at wavelengths in the first wavelength range is at a degree within the claimed range (paragraph [0062]).

With respect to dependent claims 17 and 20, the transmission of the filter device **44** of Mitchell *et al.* at wavelengths in the second and third wavelength ranges is at a degree within the claimed range (paragraph [0062]).

With respect to dependent claim 21, Struye and Van de Bergh place no limit on the construction of multiple filters. Accordingly, it is considered that the relationship of thickness between such multiple filters ranges from exactly equal to a situation where one is very much thinner than the other, consistent with desired goals of attenuation strength and good manufacturing practice to avoid peeling and the like. The “normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages.” *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1168 (Fed. Cir. 2006) quoting *In re Peterson*, 315 F.3d 1325, 1330 (Fed. Cir. 2003).

With respect to independent claim 22, Mitchell *et al.* discloses a device (FIG. **6A**) for acquiring latent image information in a phosphor layer (paragraph [0047]) comprising a light source **42** (paragraph [0061]), a detector **38** (paragraph [0083]), and a filter device **44** (paragraph [0084]). The light source, detector, and filter device of Mitchell *et al.* are all for the recited purposes, see paragraph [0062], last two sentences, regarding the transparency and lack of transparency of filter device **44** in the device of FIG. **6A**. The filter device **44** of Mitchell *et al.* is fairly characterized as an absorption filter (paragraph [0062]). Thus, the sole difference between the scope and content of Mitchell *et al.* and the claim is that Mitchell *et al.* does not identify the construction of “a filter **44**” (paragraph [0084]) as comprising at least two elements. The interchangeability of multiple filters for a single filter is recognized in the art (see column 9, lines 38-65 of Struye *et al.* and column 16, lines 19-35 of Van de Bergh). Because an express suggestion to substitute one known equivalent for another is not required (MPEP § 2144.06) it would have been obvious to one of ordinary skill in the

art at the time the invention was made to modify the filter device **44** of Mitchell *et al.* such that it comprised at least two absorption filter elements joined to one another.

With respect to dependent claim 23, see the rejection of claim 21.

Response to Submission(s)

9. The amendment filed December 1, 2008 has been entered.

10. Applicant's arguments filed December 1, 2008 have been fully considered but they are not persuasive.

Applicant has, notwithstanding the inadequacy of the disclosure to support such a recitation, presented no evidence that "integration" of a detector with a filter device is "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *See, e.g., Leapfrog Enter., Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007). It is not necessary that suggestion or motivation be found within the four corners of the references themselves. "The obviousness analysis cannot be confined by [the] formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of... the explicit content of issued patents." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct 1727, 1741 (2007). An obviousness analysis "need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take into account of the inferences and creative steps that a person of ordinary skill in the art would employ." *Id.* at 1740-741.

New claim 22 is identical to claim 9 before the amendment. To the extent that claim 9 was finally rejected and the panel decision of the pre-appeal brief review was to proceed to appeal, there is no basis to argue that claim 22 is patentable for reasons of similarity to the recitations in claim 9 as amended. The failure to present arguments pointing out the specific distinctions believed to render

claim 22 patentable over any applied references is inconsistent with the requirement of 37 CFR 1.114(c).

For at least the reasons explained above, Applicant is not entitled to a favorable determination of patentability in view of the arguments submitted December 1, 2008.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Constantine Hannaher whose telephone number is (571) 272-2437. The examiner can normally be reached on Monday-Friday with flexible hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David P. Porta can be reached on (571) 272-2444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Constantine Hannaher/
Primary Examiner, Art Unit 2884**